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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,191	06/20/2001	Kiyohiko Yokota	205494USOX PCT	3013

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EXAMINER

ASINOVSKY, OLGA NMN

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 09/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/857,191

Applicant(s)  
Yokota et al

Examiner  
Olga Asinovsky

Art Unit  
1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jun 20, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 1-9 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some\* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5 6) ☐ Other:

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Farley et al

U.S. Patent 5,874,512.

The present claim 1 discloses an olefin copolymer comprising [A] a cyclic olefin, [B] an aromatic vinyl compound and [C] an aliphatic alpha-olefin having from 2 to 20 carbon atoms, wherein the components are present in the specified proportions defined in the claim 1 such that the copolymer has a glass transition temperature of lower than 60 C.

Farley discloses a copolymer comprising a cyclic olefin monomer, an aromatic-group-containing monomer and an alpha-olefin monomer, column 2, lines 48-53, for the present claim 1.

A polymerization is produced in the presence of metallocene catalyst system having a transition

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metal compound based on group 4 and 5, column 11, lines 23-24, for the present claim 7. For introducing a catalyst into a polymerization reaction, the catalyst system is supported, for example, talc or silica-alumina, column 13, lines 41-55, for the present claim 7 (E). The obtained copolymer has a Tg preferably from greater than 30 C to about 65 C, column 16, line 54, for the present claim 1. The copolymers can include an alpha-olefin in the content of 0.5 to 90 mol%, column 16, lines 57-61; a cyclic olefin content is in the range of from 5 mol% to about 90 mol%, column 17, lines 2-9. An aromatic-group-containing monomer is present in the content from 0.1 to 10 moles to every mole of cyclic comonomer, column 16, lines 1-5. The aromatic-group-containing monomers can be present in the range of from about 0.75 mole % to about 50 mole %, column 17, lines 48-51. The contents of the ingredients for formulation an olefin composition in Farley's invention are readable in the present claims. The composition can be applied as a coating or film onto a backing material, column 20, line 54, for the present claims 8 and 9.

### ***Claim Rejections - 35 USC § 112***

2. Claims 8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 should be readable as -A film and sheet-

A method of making a film or sheet is indefinite because there is no positive active step how to make a film or sheet. See *Ex parte Erlich* 3USPQ2d 1011, 1017 (BPAI 1986).

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art is relevant to show the state of the art knowledge. The closest reference is WO 97/20872. WO 97/20872 belongs to the patent family of the discussed prior art U.S. Patent 5,874,512.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olga Asinovsky whose telephone number is (703) 308-0041. The examiner can normally be reached on Monday to Friday from 9am to 5:30pm.

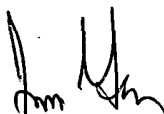
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on (703) 308-2462. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7718 and (703) 872-9311 after final.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

O.A.

O.A.

September 20, 2002

  
James J. Seidleck  
Supervisory Patent Examiner  
Technology Center 1700